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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,032	10/01/2004	Eric Berreklouw	2023-1003	4666
466 7590 06/02/2009 YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314			EXAMINER TYSON, MELANIE RUANO	
			ART UNIT 3773	PAPER NUMBER
			MAIL DATE 06/02/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/510,032

**Applicant(s)**

BERREKLOUW, ERIC

**Examiner**

Melanie Tyson

**Art Unit**

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 59-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 May 2009 has been entered. Claims 1-58 remain canceled.

### ***Response to Arguments***

Applicant's arguments with respect to claims 59-89 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 77-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 77-79 recite a "fixing device" functionally. The claims further define the structure of the fixing device. Therefore, it is unclear as to whether the fixing device is part of the applicant's claimed invention. If the fixing device is part of the claimed invention, the applicant is required to positively recite the fixing device. For examination purposes, the claims have been interpreted as written; simply requiring an applicator capable of fixing a fixing device.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 59-61, 63-65, 67-71, 76-79, and 85-89** are rejected under 35

U.S.C. 102(e) as being anticipated by **Taylor (U.S. Patent No. 6,032,672)**. Taylor discloses an assembly (see entire document) comprising a suction source (vacuum), a stabilizer (1), an instrument [applicator] (10) having a head section (for example, see Figure 2) capable of positioning a fixing device as claimed and removably positioned in the stabilizer, one or more suction nozzles (2) in the shape of a loop (they are circular), stops (12a and 12b) for fixing the instrument and stabilizer in an axial position with respect to one another, a locking mechanism that fixes the position (thus prevents rotation) of the instrument (for example, see column 5, lines 42-44), a guide (lumen 11), working ducts (9), a radial, oblique suction duct (5), and a suction line (3), wherein Taylor's device is capable of performing all the functions as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 62, 66, 72-75, and 81-84** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Taylor**.

Taylor discloses the claimed invention except for suction nozzles extending in an axial direction, sensors, and a scale provided on the guide. However, it would be obvious to one having ordinary skill in the art to change the shape of the nozzles to be axial since the applicant has not disclosed that such a configuration would provide an advantage or solve a stated problem and it appears radially, obliquely extending nozzles would perform equally well. Furthermore, it is well known in the art to add sensors to medical instruments in order to provide for an additional guide, or navigation means, for locating the instrument within the body. Therefore, it would have been obvious to one having ordinary skill in the art to have modified Taylor with a sensor to easily navigate the instrument through the body to the correct location. It is also well known in the art to provide scales on devices in order to determine the position of the device. Examples of such scales are depth-locators on cutters, syringes, and stereotaxic devices. Therefore, it would have been obvious to one having ordinary skill

in the art at the time of the invention to have modified Taylor with a scale in order to determine the position of the instrument relative to the stabilizer.

Regarding claims 72 and 73, it would have been obvious to one having ordinary skill in the art at the time the invention was made to separate Taylor's nozzles, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Regarding claims 74 and 75, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make Taylor's suction nozzles adjustable, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art.

**Claim 80** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Taylor** in view of **Gifford, III (U.S. Patent No. 5,695,504)**. Taylor discloses the claimed invention except for an instrument [applicator] that includes an elongated support member and support ring, and an obstructing member. Gifford discloses an assembly comprising an instrument [applicator] (118) capable of fixing a fixing device. Gifford teaches the instrument [applicator] includes an elongated support member (124), a support ring (102) located at the distal end of the elongated member and capable of being positioned inside a fixing device (for example, see Figure 5F), and an obstructing member (125) that is capable of moving as claimed. Taylor suggests that multiple instruments may be utilized with the disclosed assembly depending on the procedure being employed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize Gifford's instrument in Taylor's assembly if the procedure being performed required tissue clamping.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Friday 7-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./  
Examiner, Art Unit 3773  
May 30, 2009

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773